

REMARKS/ARGUMENTS

The present amendment is submitted in response to the Office Action received from the United States Patent Office dated November 9, 2007. In the Office Action, the Patent Office rejected Claims 1-8 and 12 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Additionally, the Patent Office rejected Claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over *Tanaka et al.* (United States Patent Number: 4,857,677) in view of *Allison et al.* (United States Patent Number: 3,311,718). Additionally, the Patent Office rejected Claims 1, 7 and 8 on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-3, 10, 11 and 14 of United States Patent Number: 7,109,430.

Applicant respectfully submits that the application overcomes the rejections raised by the Patent Office. Applicant further submits that the application is now in condition for allowance. Notice to that effect is requested. Additionally, applicant submits herewith two terminal disclaimer in response to the non-statutory obviousness type double patenting and rejection over pending “reference” application.

The Patent Office rejected Claims 1-8, and 12 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Patent Office states that Claim 1, line 4-5, it is not clear what is meant by “wherein the detent sub-assembly is enclosed and operates independent of the knob.” According to Figure 3, the knob 305 is connected to shaft 365 by screw and the detent sub-assembly comprises sprocket 326, rotor 324, spring 320, ball 322 and cap 315 and sprocket 326 is held by locking screw 329 against bushing 355 and the rotation of the shaft causes rotor, spring with associated balls and electrical contacts to rotate. Thus part of the detent subassembly rotates by rotation of the knob and therefore, the recitation “wherein the detent subassembly is enclosed and operates independent of the knob is contrary to the disclosure.”

Applicant respectfully disagrees with the Patent Office. On page 3, line 24-26 and page 4, lines 1-3 specifically describe the claimed aspect. More specifically, “in the present subject matter, the detent sub-assembly is fully enclosed independent of the knob (i.e.- not housed in the

knob). The knob 175 is simply held to the shaft by one or more locking screws 177, and the operation of the detent sub-assembly 180 is not altered by removal of the knob 175. Clearly the specification supports the claims that the detent sub-assembly is enclosed and operated independent of the knob. Applicant respectfully requests that the Patent Office withdraw the rejection of Claims 1-8 and 12 under 35 U.S.C. §112, second paragraph.

The Office rejected claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over *Tanaka et al.* in view of *Allison et al.* (United States Patent 3,311,718). The Patent Office states that Regarding claims 1, 5, 6 and 9-12, Tanaka et al. discloses a rotary switch mounted above and below the panel, comprising: a panel, a rotary switch mounted below the panel, a circuit board with contacts and a knob that substantially covers the detent sub-assembly, the detent subassembly operates with the knob.

Previously amended claim 1 requires a rotary switch mounted above and below a panel, comprising: sealing member disposed between a portion of the switch and an underside of the panel; a detent sub-assembly located entirely above the panel. Additionally, Claim 1 further requires a knob that substantially covers the detent sub-assembly wherein the detent sub-assembly is enclosed and operates independent of the knob and further wherein only a bushing and shaft extend through the panel.

Previously amended claim 10 requires a method of selecting an electrical circuit using a panel mounted rotary switch, the method comprising the steps of: providing a shaft that cooperates with an independent detent sub-assembly located entirely on a user's side of the panel, wherein the shaft is coupled to an electrical connection on an underside of the panel and further wherein the detent sub-assembly is completely on one side of the panel and the rotary switch is located on the underside of the panel and not within the detent sub-assembly;

Tanaka et al. does indeed disclose a switch with a sub-assembly on the user side of the panel, but fails to teach, suggest, or motivate a knob that substantially covers the detent sub-assembly and is independent of the detent sub-assembly. As illustrated above, and by the Patent Office's own admission, the detent sub-assembly operates WITH the knob in Tanaka et al. The specification and the claims of the present invention specifically state that the detent subassembly is operated independent of the knob.

Allison also demonstrates a knob that is housed inside and not independent to the detent sub-assembly. (See col. 2, lines 36-44 of *Allison*). *Allison* does not teach or suggest a method of selecting an electrical circuit using a panel mounted rotary switch, comprising: providing a shaft that cooperates with an independent detent sub-assembly located entirely on a user's side of the panel, wherein the shaft is coupled to an electrical connection on an underside of the panel and further wherein the detent sub-assembly is completely on one side of the panel as required by claim 10. Thus, neither *Tanaka et al.* nor *Allison* disclose, teach or suggest what is recited in independent Claims 1, 10 and 11.

With respect to *Tanaka*, while it teaches a dial knob to be operated independent of the detent sub-assembly, the detent sub-assembly still resides within the knob. (See figures 4 and 5, col. 4, lines 63-65). A shaft in *Tanaka* holds as the base to connect the knob and detent sub-assembly into one structure and thus the knob is not housing the detent sub-assembly independently. Further, *Tanaka* does not disclose the shaft and bushing extending through the panel to attach the detent sub-assembly to the switch. Thus, neither *Allison* nor *Tanaka* teaches or even suggests the embodiment of claim 1.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicants' invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, the rejection of Claims 1, 3-8 and 9-12 under U.S.C. §103(a) as being unpatentable over *Lemire* in view of *Allison et al.*, has been overcome and should be withdrawn. In view of the foregoing remarks and amendments, it is submitted that the rejection of Claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over *Fowler et al.* in view of *Tanaka et al.* and further in view of *Allison et al.* has been overcome. Notice to that effect is requested.

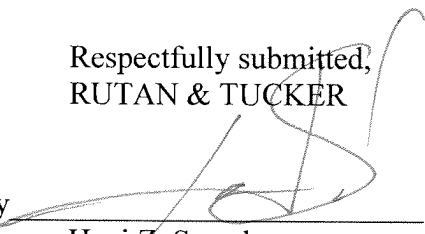
Claims 2-9 depend from Claim 1; and Claim 12 depends from Claim 11. These claims are further believed allowable for the same reasons set forth with respect to independent Claims 1 and 10 and 11 since each sets forth additional novel elements of Applicant's Low profile rotary switch.

The Commissioner is hereby authorized to deduct filing fees of the Terminal Disclaimer from Deposit Account No. 50-2191.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,
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